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Paper No. 7

PETRINA S. HSI  
HYSEQ, INC.  
670 ALMANOR AVENUE  
SUNNYVALE, CA 94085

**COPY MAILED**

**MAR 18 2003**

**OFFICE OF PETITIONS**

In re Application of :  
Shubhada Godbole, Bryan Boyle, :  
Nancy Mize, Cenhua Deng, :  
Ryle Goodrich, Matthew Arterburn, :  
Ping Zhou, Y. Tom Tang, :  
Chenghua Liu, George Yeung and :  
Radoje Drmanac :  
Application No. 09/756,247 :  
Filed: January 8, 2001 :  
Title: INFORMATION PROCESSING :  
APPARATUS AND METHOD, AND RECORDING: :  
MEDIUM THEREFOR :

DECISION REFUSING STATUS  
UNDER 37 C.F.R. § 1.47(a)

This is in response to the "Petition under 37 C.F.R. § 1.47(b)," filed May 8, 2002 (certificate of mailing April 29, 2002). This petition is properly treated as a petition under § 1.47(a)<sup>1</sup>.

The petition is **DISMISSED**.

Rule 47 applicant is given **TWO MONTHS** from the mailing date of this decision to reply, correcting the below-noted deficiencies. Any reply should be entitled "Request for Reconsideration of Petition Under 37 C.F.R. §1.47(a)," and should only address the deficiencies noted below, except that the reply may include an oath or declaration executed by the non-signing inventor. **Failure to respond will result in abandonment of the application.** Any extensions of time will be governed by 37 C.F.R. § 1.136(a).

The above-identified application was filed on January 8, 2001, with an unexecuted declaration. Shubhada Godbole, Bryan Boyle, Nancy Mize, Cenhua Deng, Ryle Goodrich, Matthew Arterburn, Ping Zhou, Y. Tom Tang, Chenghua Liu, George Yeung and Radoje Drmanac were named as joint inventors. Accordingly, on December 18, 2001, applicants were mailed a "Notice to File Missing Parts of Nonprovisional Application - Filing Date Granted (Notice)," requiring an executed oath or declaration and a surcharge for its late filing. This Notice set a two-month period for reply with extensions of time obtainable under § 1.136(a).

In response, applicants filed four separate declarations, identifying all inventors and executed in combination by all of the joint inventors, except inventor Godbole; the surcharge under

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<sup>1</sup> Filing under 37 C.F.R. § 1.47(b) is only proper where no inventors are available to join in the application.

§ 1.16(1); and the instant petition under § 1.47(a). This response was made timely by an accompanying petition for extension of time within the third month. Applicants assert that status under § 1.47 is proper because inventor Godbole refuses to join in the application. Applicants request that patent attorney Luisa Bigornia be allowed to make application on behalf of the non-signing inventor. In support of the petition, applicants submit a statement of facts of attorney Bigornia.

A grantable petition under 37 C.F.R. § 1.47(a) requires: (1) proof that the non-signing inventor cannot be reached or found, after diligent effort, or refuses to sign the oath or declaration after having been presented with the application papers (specification, claims and drawings); (2) an acceptable oath or declaration in compliance with 35 U.S.C. §§115 and 116; (3) the petition fee; and (4) a statement of the last known address of the non-signing inventor. The instant petition does not satisfy requirement (1).

As to requirement (1), petitioner has not shown that inventor Godbole has refused to join in the application as required by § 1.47. Before a refusal can be alleged, applicants must demonstrate that a *bona fide* attempt was made to present a copy of the application papers (specification, including claims, drawings, and oath or declaration) to the non-signing inventor. See MPEP 409.03(d). The statement of facts of attorney Bigornia, and supporting copy of cover letter of transmittal, only indicate that a declaration and power of attorney were presented to inventor Godbole. A refusal by an inventor to sign an oath or declaration when the inventor has not been presented with the application papers does not itself suggest that the inventor is refusing to join the application unless it is clear that the inventor understands exactly what he or she is being asked to sign and refuses to accept the application papers. It is reasonable to require that the inventor be presented with the application papers before a petition under 37 CFR 1.47 is granted since such a procedure ensures that the inventor is apprised of the application to which the oath or declaration is directed. *In re Gray*, 115 USPQ 80 (Comm'r Pat. 1956). Petitioners have not provided evidence that the application papers (specification, including claims, drawings, and oath or declaration) were all presented to inventor Godbole for his signature.

Thus, on renewed petition, applicants must establish that the entire application package, including specification, claims and drawings, was presented to non-signing inventor Godbole and he subsequently refused to sign. If they have not already been sent, a copy of the application papers should be sent to the last known address of the non-signing inventor, or, if the inventor is represented by counsel, to the address of the non-signing inventor's attorney. Documentary evidence, including copies of the transmittal cover letters and return mail receipts, should be made part of the record.

As to requirement (2), applicants request that attorney Bigornia be allowed to make application on behalf of the non-signing

inventor<sup>2</sup>. However, 37 CFR 1.47(a) and 35 U.S.C. 116, second paragraph, require all available joint inventors to file an application "on behalf of" themselves and on behalf of a joint inventor who "cannot be found or reached after diligent effort" or who refuses to "join in an application." Thus, in addition to other requirements of law (35 U.S.C. 111(a) and 115), in an application deposited in the U.S. Patent and Trademark Office pursuant to 37 CFR 1.47(a):

(A) All the available joint inventors must (1) make oath or declaration on their own behalf as required by 37 CFR 1.63 or 1.175 (see MPEP §602, §605.01, and §1414) and (2) make oath or declaration on behalf of the non-signing joint inventor as required by 37 CFR 1.64. An oath or declaration signed by all the available joint inventors with the signature block of the non-signing inventor(s) left blank may be treated as having been signed by all the available joint inventors on behalf of the non-signing inventor(s), unless otherwise indicated.

(Emphasis added).

The declarations submitted on petition are signed, in combination, by all of the available joint inventors with the signature block for inventor Godbole left blank. Despite the assertions that the application was being made by attorney Bigornia, the declarations do not bear the signature of attorney Bigornia. Accordingly, it is concluded that the declaration filed May 8, 2002 may be accepted as signed by the available

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<sup>2</sup> As this is properly a petition under § 1.47(a), application by attorney Bigornia is not appropriate. (If this were a 1.47(b), a further showing by attorney Bigornia would be required. In this regard, petitioner's attention is directed to MPEP 409.03(b) (A):

The 37 CFR 1.47(b) applicant must make the oath required by 37 CFR 1.63 and 1.64 or 1.175. Where a corporation is the 37 CFR 1.47(b) applicant, an officer (President, Vice-President, Secretary, Treasurer, or Chief Executive Officer) thereof should normally sign the necessary oath or declaration. A corporation may authorize any person, including an attorney or agent registered to practice before the U.S. Patent and Trademark Office, to sign the application oath or declaration on its behalf. Where an oath or declaration is signed by a registered attorney or agent on behalf of a corporation, either proof of the attorney's or agent's authority in the form of a statement signed by an appropriate corporate officer must be submitted, or the attorney or agent may simply state that he or she is authorized to sign on behalf of the corporation. Where the oath or declaration is being signed on behalf of an assignee, see MPEP § 324. An inventor may not authorize another individual to act as his or her agent to sign the application oath or declaration on his or her behalf. *Staeger v. Commissioner*, 189 USPQ 272 (D.D.C. 1976), *In re Striker*, 182 USPQ 507 (Comm'r Pat. 1973). Where an application is executed by one other than the inventor, the declaration required by 37 CFR 1.63 must state the full name, residence, post office address, and citizenship of the nonsigning inventor. Also, the title or position of the person signing must be stated if signing on behalf of a corporation under 37 CFR 1.47(b).

joint inventors on behalf of themselves and on behalf of non-signing inventor Godbole. This declaration has been reviewed and found in compliance with § 1.63.

On renewed petition, applicants must correct the following deficiency:

Provide adequate proof of presentation of all of the application papers to inventor Godbole and of his subsequent refusal, consistent with the guidance set forth in MPEP 409.03(d)<sup>3</sup>.

The change of correspondence address filed August 12, 2002, is acknowledged and made of record.

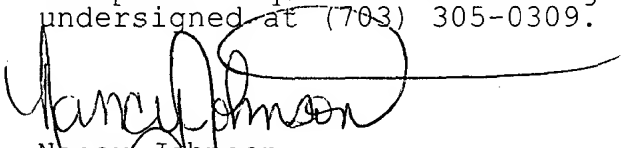
Further correspondence with respect to this matter should be addressed as follows:

By mail: Commissioner for Patents  
Box DAC  
Washington, DC 20231

By FAX: (703)308-6916  
Attn: Office of Petitions

By hand: Crystal Plaza Four, Suite CP4-3C23  
2201 South Clark Place  
Arlington, VA 22202

Telephone inquiries concerning this matter may be directed to the undersigned at (703) 305-0309.



Nancy Johnson  
Petitions Attorney  
Office of Petitions

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<sup>3</sup> 8th ed. (Rev. Aug 1, 2001).